

REMARKS

Claims 1-20 remain in the application.

The Office Action objects to claims 1, 7, 11, and 12 for indefiniteness. The applicant has amended these claims to remove the terms identified as being indefinite. The Applicant maintains that the scope of these claims has not changed as a result of these amendments since the clauses removed were non-limiting, merely illustrative statements.

The Office Action objects to claim 14 because the term “upper reflector portion” lacks antecedent basis. The applicant has amended the term to remove the word “reflector,” the remaining term “upper portion” having antecedent basis in claim 10.

**REJECTION OF CLAIMS 1-6 UNDER 35 U.S.C. § 102(b)**

The Office Action rejects claims 1-6 under 35 U.S.C. § 102(b) as being anticipated by McNair et al. (US 4,520,436). According to the Office Action, McNair discloses all the limitations of these claims.

As defined in the amended claim 1, the subject invention comprises a module removably supported on a housing and carrying a lamp socket, the lamp socket being removable from the lamp housing with the module. In other words, the lamp socket is carried by the module.

In contrast, the McNair socket 68 isn't carried by the McNair module 10 nor is it removable from the McNair lamp housing 50 with the McNair module. Instead, the McNair socket 68 is carried by a bracket 64 in the McNair lamp housing 50 as shown in Figure 2 and remains behind when the McNair module 10 is removed. Neither is there

any suggestion in the prior art of record or general knowledge to modify such a module to carry a socket.

Therefore, the Applicant maintains that McNair doesn't anticipate amended claim 1.

The applicant also maintains that claims 2-5 are allowable because they depend from an allowable base claim.

The Office Action rejects claims 7-9 under 35 U.S.C. § 102(b) as being anticipated by McNair et al. (US 4,520,436). According to the Office Action, McNair discloses all the limitations of these claims.

In response, the Applicant has amended claim 7 to more clearly recite that both the lamp socket and the ballast are carried by the module and are both removable with the module from the housing.

The Applicant maintains that McNair neither discloses nor suggests such a feature. Instead, as explained above with regard to claim 1, the McNair socket 68 is carried by a bracket 64 in the McNair lamp housing 50 and is not removable with the McNair module 10.

Accordingly, the Applicant maintains that McNair doesn't anticipate claim 7.

Regarding claim 8, the Office Action states that, as shown in Figure 1 of the McNair patent, "the lamp module 10 carries a lamp socket 14 . . ." The Applicant asks that the Examiner reconsider this finding since it's apparent from Figure 1 that the structure called-out by reference numeral 14 is a lamp base rather than a lamp socket. While the McNair lamp base 14 is carried by and is removable with the McNair module

10, the McNair lamp socket 68 is not. For this reason, the Applicant maintains that McNair doesn't anticipate claim 8.

The Applicant also maintains that claims 8 and 9 are allowable since they depend from an allowable base claim.

#### **REJECTION OF CLAIMS 10-16 UNDER 35 U.S.C. § 102(b)**

The Office Action rejects claims 10-16 under 35 U.S.C. § 102(b) as being anticipated by McNair et al. (US 4,520,436). According to the Office Action, McNair teaches a downward illumination assembly that claim 10 accurately describes. However, in explaining this finding, the Office Action describes the prior art lamp apparatus shown in Fig. 3 of the McNair patent as including "a trim bezel 80 having an upper portion in the flange extending laterally outward supporting the ceiling 70 with a frictional fit". The Applicant asks that the Examiner reconsider this analysis for three reasons:

First, this is not what claim 10 recites. Instead, claim 10 requires that the trim bezel include an upper portion that, unlike the prior art trim bezel 80, is:

- supportable by friction fit (rather than supporting a ceiling by friction fit);
- supportable by friction fit within a lamp housing (rather than a hole in a ceiling panel) and
- supportable *in any position within a range of axial positions* within the lamp housing (rather than being supported in a fixed axial position. McNair neither teaches nor suggests any of these features.

Second, upon closer inspection, it becomes apparent that what McNair shows in Figure 3 is not a frictional fit with the lamp housing 50, but rather, a pair of springs 82 that suspend the trim ring 80 from a lamp housing 50 and bias the trim 80 in place using spring tension rather than friction (See column 5 at lines 17 and 18).

Third, the use of springs 82 to suspend and upwardly bias the trim ring 80 teaches away from the existence of a frictional fit between the ceiling 70 and the trim bezel 80 since friction between the ceiling 70 and the trim bezel 80 would defeat the bias function of the springs 82.

Accordingly, the Applicant maintains that McNair doesn't anticipate claim 10 and that claim 10 is allowable.

The Applicant also maintains that claims 11-16 are allowable because they depend from an allowable base claim.

In response, the Applicant has amended base claim 11 to recite that the module can be removed from the lamp housing from a position above the ceiling panel.

#### **REJECTION OF CLAIMS 17 AND 19-20 UNDER 35 U.S.C. § 102(b)**

The Office Action rejects method claims 17 and 19-20 under 35 U.S.C. § 102(b) as being anticipated by McNair et al. (US 4,520,436). According to the Office Action, McNair discloses all the limitations of these claims. However, in explaining the rejection of this method claim the Office Action identifies corresponding structures in McNair and states that the abstract teaches that the apparatus can be accessed in the area above the ceiling. The Applicant asks that the Examiner reconsider this analysis for two reasons:

First, the abstract does not appear to either teach or suggest a step of gaining access to the McNair lamp apparatus in an area above the ceiling.

Second, while the McNair lamp apparatus may, in some sense, be "accessed" from above the ceiling panel in the sense that it might be touched or viewed from above; there is no teaching or suggestion in McNair that satisfies any of the following limitations of claim 17:

- a method for servicing components of a downward illumination assembly (McNair neither discloses nor suggests component servicing methods except for lamp replacement at column 6, lines 10-34 and lines 64-68);

- providing a downward illumination assembly including a module *removably* supported on a lamp housing and carrying components of the assembly (the McNair ballast housing 112 is riveted or spot welded to the lamp sockets 116, which are riveted or spot welded to the reflector 120 as described at column 5, lines 41-49; Even if the lamp 10 were construed as being the “module”, McNair only discloses servicing the lamp module 10 from below a ceiling by unscrewing and replacing it with a new module);

- gaining access to the area above the ceiling panel
- removing the module from the lamp housing
- servicing a component carried by the module (again, McNair only discusses lamp replacement – not the servicing of lamp components)
- re-installing the module on the lamp housing

Regarding claim 20, the Office Action describes a lamp housing 50 shown in Figure 3 of the McNair patent as “having a trim bezel 80 attaches (sic) to spring clips 82.” The applicant understands this statement to mean that the Office Action construes the trim bezel 80 to attach to the housing 50 via spring clips 82. The applicant asks that the Examiner reconsider this finding for the following reasons:

- Claim 20 recites that the step of inserting the upper portion of the trim bezel into the housing includes causing spring clips supported on the trim bezel to engage an inner surface of the housing wall;

- The items called out by reference numeral 82 in Figure 3 of the McNair patent are coil springs rather than spring clips;

- McNair neither discloses nor suggests causing the springs 82 to engage an *inner surface of the housing wall*. Instead, the springs 82 engage slots 84 in the housing wall – there’s no evidence that any portion of the springs even contacts the inner surface of the housing wall; and

- McNair neither discloses nor suggests causing the springs 82 to engage

the housing 50 *as part of the step of inserting an upper portion of the trim bezel 80 into the housing 50.*

In addition, the Applicant maintains that claims 18-20 are allowable because they depend from an allowable base claim.

The Office Action further argues that it's inherent to provide a method for servicing the lamp apparatus since McNair et al meet all the limitations of the claimed invention. The Applicant asks that the Examiner reconsider this reasoning for the following reasons:

- Even if it were inherent to provide a method for servicing the lamp apparatus, it would not be inherent to service the lamp apparatus as claimed; and
- For McNair to anticipate any of these claims without actually describing the claimed structure or method steps there must be extrinsic evidence that the missing descriptive matter is *necessarily present* in the device or method described in the reference, and that persons of ordinary skill would so recognize it. *Continental Can Co., U.S.A. v. Monsanto Co.*, 948 F.2d 1264, 1268-69 20 U.S.P.Q.2d 1746, 1749-50 (Fed.Cir.1991). Moreover, inherency may not be established by probabilities or possibilities. *Id.* The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. *Id.*

The Office Action has provided no evidence that a method for servicing the McNair lamp apparatus must (rather than might) include gaining access to the area above the ceiling panel, servicing a component carried by the lamp apparatus (rather than simply replacing it), or causing spring clips to engage an inner surface of the housing wall while inserting an upper portion of the trim bezel into the housing. Instead, what McNair actually discloses is simply replacing the lamp apparatus – and doing so from below the ceiling panel. In other words, McNair's own disclosure of an alternate

servicing method (replacement from below) precludes a finding that the claimed method is necessary and therefore inherent in the McNair apparatus.

#### **REJECTION OF CLAIM 18 UNDER 35 U.S.C. § 103(a)**

The Office Action rejects claim 18 under 35 U.S.C. § 103(a) as being unpatentable over McNair in view of Mandy (US 5,003,432). According to the Office Action, McNair discloses the claimed method except that the step of providing a downward illumination apparatus supported on a ceiling panel doesn't include providing such an apparatus supported on a ceiling panel *in a passenger elevator*. According to the Action, it would have been obvious "to combine the light apparatus of McNair et al. with the lighting system of Mandy "to provide a method of illuminating a housing area with illumination with a fluorescent lamp as taught by Mandy."

The Applicant disagrees for the following reasons:

- Claim 18 doesn't disclose a method of illuminating. Instead, claim 18 recites opening an access door in a top panel of an elevator where the ceiling panel is supported in a passenger elevator;
- Neither McNair nor Mandy either disclose or suggest servicing a ceiling-mounted lamp from a position above the ceiling;
- Neither McNair nor Mandy either disclose or suggest opening an access door in a top panel of an elevator; and
- The Office Action doesn't present a *prima facie* case for obviousness because the action doesn't properly support its obviousness determination. It's well settled that, to support an obviousness determination based on a combination of prior art references, you must show why a skilled person, *confronted with the same problems as the inventor* and with no knowledge of the claimed invention, would select elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457-1458 (Fed. Cir. 1998). The courts have held that an examiner, to

support such an obviousness finding, must show evidence of a motivation to combine the references that create the case of nonobviousness. See, e.g., *In re Rouffet* at 1457-1458.

Evidence of motivation to combine may come in the form of an express teaching or suggestion in the prior art or in knowledge generally available to one of ordinary skill in the art. See, e.g., *In re Oetiker*, 24 USPQ2d 1443, 1446-1447 (Fed. Cir. 1992). Evidence of motivation may also be found in “the nature of the problem to be solved, leading inventors to look to references relating to possible solutions to that problem.” *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.* 37 USPQ2d 1626, 1630 (Fed. Cir. 1996); See also, e.g., *In re Rinehart*, 189 USPQ 143, 149 (CCPA 1976); *In re Rouffet* at 1458; *Para-Ordinance Mfg. v. SGS Imports Intern., Inc.* 37 USPQ2d 1237, 1240 (Fed. Cir. 1995); *In re Oetiker* at 1446-1447. In other words, if an examiner is unable to find evidence of motivation in an express teaching or suggestion in the prior art or knowledge generally available to one of ordinary skill in the art, the examiner can still show an implicit motivation to combine with evidence that one skilled in the art, confronted with the same problem as the inventor, would know to use a prior art teaching to solve that problem, i.e., the problem that the Applicant sought to solve through the invention in question. *Id.* For this to be the case the problem that the invention solves must be the same as or at least similar to the problem that the prior art teaching solves. *In re Rinehart* at 149; *Para-Ordinance* at 1240; *Motorola, Inc. v. Interdigital Technology Corp.*, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997)(“the record evidence supports the jury’s implicit finding of a suggestion to combine the various references . . .[which] were related and involved similar problems and issues.”); *In re Zurko*, 59 USPQ2d 1693 (Fed. Cir. 2001) (“to say that the missing step comes from the nature of the problem to be solved begs the question because the Board has failed to show that this problem had been previously identified anywhere in the prior art.”).



In any case, it's not enough to simply identify an advantage that the suggested combination would share with the claimed invention. If the combination reaches the invention, then it will *always* and *necessarily* provide the same advantages as the invention. To conclude that an invention is obvious because a combination of prior art references that produces the same invention would provide the same advantages, is no different from defining an obvious invention as being one that provides the same advantages as itself. Since this is true of all inventions, the existence of such an advantage is incapable of distinguishing between obvious and non-obvious inventions. Accordingly, it appears that the existence of such an advantage is used to support an obviousness determination motivated by a subjective feeling or sense that an invention is obvious, but where there is a lack of objective evidence of a teaching or suggestion in the prior art or general knowledge.

To distinguish between obvious and non-obvious combinations one must instead produce evidence of a teaching or suggestion that would have motivated one skilled in the art to combine those particular references in such a way as to *realize* the advantage. To reason that the advantage of the combination can, itself, serve as the motivation to combine is, therefore, essentially tautological. It short-circuits the proper analysis and can be used to mischaracterize *any* inventive combination as being obvious.

For the above reasons, the Applicant maintains that claim 18 is patentable over McNair in view of Mandy (US 5,003,432).

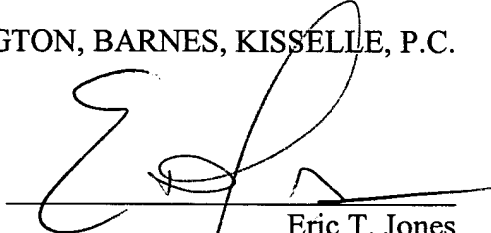
Claims 1-20 recite patentable subject matter and are allowable. Therefore, the Applicant respectfully submits that the application is now in condition for allowance and respectfully solicits such allowance. Please favorably reconsider the outstanding Office Action.

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I authorize the Assistant Commissioner to charge any deficiencies, or credit any overpayment associated with this communication to Deposit Account No. 50-0852. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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